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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,171	10/12/2001	Ji-Rong Wen	MS1-936US	2858
22801	7590	08/10/2005	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			WOO, ISAAC M	
			ART UNIT	PAPER NUMBER
			2162	
DATE MAILED: 08/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,171

Applicant(s)

WEN ET AL

Examiner

Isaac M. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6,8,10,12-16,18,20,22-26,28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6,8,10,12-16,18,20,22-26,28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/8/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 08, 2005 has been entered.

2. Claims 2-6, 8, 10, 12-16, 18-20, 22-26, 28 and 30 are amended. Claims 1, 7, 9, 11, 17, 19, 21, 27 and 29 are canceled. Claims 2-6, 8, 10, 12-16, 18, 20, 22-26, 28 and 30 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 2-6, 8, 10, 12-16, 18 and 20 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

A. Identify and Understand Any Practical Application Asserted for the Invention

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Regarding claims 5, 8 and 10, a method for clustering queries, can be implemented without computer or machine. Because the limitation of claims 5, 8 and 10 "identifying" and "response to identifying" can be implemented by a human without any computer or machine. Thus, the languages of claims 5, 8 and 10 raise a question as to whether the claimed method is directed merely to an abstract idea that is not tied to a producing a concrete, useful, and tangible result to from the basis of statutory subject matter under 35 U.S. C. § 101. Therefore, the claimed invention is non-statutory subject matter. The claims should be amended to indicate that the subject matter is implemented by a computer, i.e., a computer implemented method.

Regarding claims 12-16, 18 and 20, computer-readable media for identifying similar queries, with *no hardware and software combination*. Because the limitation of claims 15, 18 and 20, "identifying" and response to identifying" are computer program (computer-executable instructions) software system that are embedded a computer-readable medium but not run by any a computer or machine. Therefore, the claims are not a statutory system and should be rejected under 35 U.S. C. § 101 as not being tangible.

Claim Rejections - 35 USC § 112

5. Claims 5, 8, 10, 15, 18, 20, 25, 28 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 8, 10, 15, 18, 20, 25, 28 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites "that" in lines 17. Claim 8 recites "such that" in lines 7 and "that " in line 13. Claim 10 recites "such that" in line 10 and "that" in line 19. Claim 15 recites "that " in line 19. Claim 18 recites "such that" in line 9 and "that" in line 15. Claim 20 recites "such that" in line 12 and "that" in line 22. Claim 25 recites "that " in line 20. Claim 28 recites "such that" in line 10 and "that" in line 16. Claim 30 recites "such that" in line 13 and "that" in line 23. Pronouns are not permitted, only what is being referred by "that" should be set forth in the claim. May be renders the claim indefinite by failing to point out hat is being performed. Applicants are advised to amend the claim so solve the 112 rejection set forth in the claim.

6. 5, 8, 10, 15, 18, 20, 25, 28 and 30 are rejected under 35 U.S.C. 112, second paragraph as being insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the similar documents being determined by" in lines 5-6. Claim 8 recites the limitation "the similar documents" in line 5. Claim 10 recites the

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limitation "the similar documents being" in line 4. Claim 15 recites the limitation "the similar documents being determined" in lines 7-8. Claim 18 recites the limitation "the similar documents being determined" in lines 7-8. Claim 20 recites the limitation "the similar documents being based on" in lines 6-7. Claim 25 recites the limitation "the similar documents being determined" in lines 9-10. Claim 28 recites the limitation "the similar documents being determined" in lines 9-10. Claim 30 recites the limitation "the similar documents being based on" in lines 7-8. There is insufficient antecedent basis for this limitation in the claim.


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW
August 1, 2005


JEAN M. CORRIELUS
PRIMARY EXAMINER